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MAY 7 1953
HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1952

No. 709

FRANK ADAM ELECTRIC COMPANY,
Petitioner,

vs.

FEDERAL ELECTRIC PRODUCTS COMPANY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Preliminary Statement

The two statutes under which the District Court and the Court of Appeals held the reissue patent invalid and dismissed the complaint are the disclaimer statute, 35 U. S. C. A. Sections 65 and 71 and the reissue statute, 35 U. S. C. A. 64, the directly pertinent provisions of which are set forth in the record, page 235, in the opinion of the Court of Appeals.

The facts to which the District Court and the Court of Appeals have applied these statutes, in holding the patent invalid, are either admitted or are not in dispute (Pet. 2), but a more detailed statement of the facts than in the petition will presently be made herein because it is considered that a complete, although short, exposition of the facts will serve to indicate that the questions as drafted and presented by the petitioner (Pet. 4-5) are not substantiated by the facts.

The petition and supporting brief do not describe the patent in suit. However, the patent and the similar prior art devices are described in the record beginning at page 077, and by reference thereto it will be noted that the patent relates to fused electric switches of the pull out or plug type and deals with only small, if any, differences over the prior art.

The opinion of the Court of Appeals is reported in 200 F. (2nd), 210 and is in the record, pages 233-239. Petition for rehearing was denied (R. 251).

Concise Statement of Facts

Petitioner's original Patent No. 2,186,813 (R. 109) was issued January 9, 1940 inadvertently while a patent application of Jackson and Kingdon for a similar device was still pending in the Patent Office. This Jackson and Kingdon application matured into Patent No. 2,289,122 on July 7, 1942 (R. 195) following a contest of priority of invention (known as an interference proceeding) with said original patent. After some delay, petitioner and its assignors conceded in writing that their adversaries, Jackson and Kingdon, were the prior inventors and judgment of priority was thereupon immediately awarded to Jackson and Kingdon by the Patent Office (R. 082-083). As stated in the decision of the Board of Interference Examiners of the Patent Office (R. 082) the petitioner and its assignors, Adam and Stieglitz, had filed a formal concession of priority of invention to Jackson and Kingdon and shortly thereafter, namely on October 31, 1941, petitioner filed a disclaimer with respect to the claims which were involved in the interference, namely claims 13, 14, 18 and 19 of petitioner's original patent (R. 083-084). This disclaimer, however, was not an outright disclaimer but on the contrary added elements to the claims and was therefore invalid, as now admitted by petitioner.

The concession of priority and the invalid disclaimer are set out in full in the record at pages 032 and 034. On July 9, 1942, some eight to nine months following the filing of the concession of priority and the disclaimer, and following the adverse judgment rendered thereon by the Patent Office, petitioner filed an application for reissue of the original patent, and the patent in suit No. Re. 22,266 was issued on February 16, 1943 (R. 093). In the oath submitted in support of the reissue application (R. 034 to R. 036), it was specifically stated that the inadvertence, accident or mistake necessary to justify the reissue of a patent under the reissue statute, 35 U. S. C. A. 64 (R. 235), was constituted by the invalid disclaimer (R. 035-036).

The reissue application included the disclaimed claims as modified by the admittedly invalid disclaimer and all of the other claims of the original patent and issued with all of these claims without change, and without any change in the specification (R. 085). No other claims were ever presented in the reissue application and no changes were ever sought to be made in the specification. The original patent (as modified by the disclaimer) and the reissue patent are identical except as to form, but petitioner never called the attention of the Patent Office to the fact that its reissue application was exactly the same as its original patent as modified by the invalid disclaimer.

No disclaimer whatsoever has ever been filed in the reissue patent (R. 207).

The only pleading in this case is the complaint filed in the District Court on April 14, 1951 (R. 062). This complaint was dismissed on defendant's motion for summary judgment without any intervening pleading (R. 011). This motion was sustained by the District Court (R. 054 to 058) and the Court of Appeals affirmed.

The Admittedly Invalid Disclaimer

The invalidity of the disclaimer under the law emphasized by this Court in *Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U. S. 477, and again in *Milcor Steel Co.* v. *Fuller*, 316 U. S. 143, because the disclaimer was not an outright disclaimer of the claims lost in the interference but added elements to said claims is nowhere disputed in the petition and supporting brief. On the other hand, Judge Moore of the District Court exposed the futility of any argument for validity by pointing out:

> "* * ** since priority of invention as to the four claims in question had been conceded, the claims must obviously be invalid for want of invention, unless a new element is added" (R. 055).*

Petitioner has abandoned its contention that the law emphasized in the *Altoona* and *Milcor* cases does not apply to the disclaimer, but argues in effect that it thought the law was otherwise when it filed the disclaimer. Thus, in the oath submitted in the reissue application, the petitioner (R. 035) said:

> "* * * and deponents further say that the errors, which render such patent so invalid in part, arose from inadvertence, accident or mistake and without any fraudulent or deceptive intention on their part; that the following is a true specification of the errors, which it is claimed constitute such inadvertence, accident or mistake relied upon:
>
> That the aforesaid claims 13, 14, 18 and 19 became involved in an Interference Proceeding after the issuance of the aforesaid patent and it was then discovered that the said claims were subject to an interpretation whereby they might embrace subject matter of which deponents were not the original inventors, to wit, structures in which the bar members

* These four claims are claims 9 to 12 of patent 2,289,122 (R. 203) issued to the prior inventors.

were not positioned both laterally and transversely by engagement with the overlying and underlying portions of the base together with the side walls of the 'opening' or 'slot'; that upon discovery of the fact that said claims were too broad and, to the extent of such undue breadth, were beyond the purview of the Specification, a disclaimer was made by deponents' assignee pursuant to the provisions of the statutes of the United States in such cases, made and provided, whereby deponents' assignee disclaimed from the scope of the aforesaid claims 13, 14, 18 and 19 the subject matter possibly embraced thereby but beyond the purview of the Specification. That, in a decision rendered April 27, 1942 in the case of Milcor Steel Company v. George A. Fuller Company et al., the Supreme Court of the United States has indicated that the character of the disclaimer adopted by deponents' assignee, is such that the aforesaid claims 13, 14, 18 and 19 of said patent might be rendered wholly invalid."

But, as stated, petitioner did not even then surrender the invalid claims but carried them over *in toto* into the reissue and they now appear therein, without disclaimer, as claims 13, 14, 18 and 19 without change from the original claims of the same numbers as amended by the disclaimer before the reissue was filed.

Summary of Argument

The points relied upon by the petitioner will be dealt with seriatim in this summary, as well as more specifically under the headings indicating refutation of said points, respectively, but it is submitted at the outset that the reissue patent in suit is obviously invalid because it is the same in all respects, except only in form, as the invalid original patent as modified by the disclaimer.

The Court of Appeals decided that the reissue patent in suit is invalid for either of the two following reasons: (1)

delay in filing the application for reissue, and (2) failure to prove that the error sought to be corrected by the reissue had arisen by inadvertence, accident or mistake, in view of the facts that the filing of the invalid disclaimer and the concession of priority were deliberate acts and not the result of inadvertence. 35 U. S. C. A. 64 (R. 235); *Leggett* v. *Avery*, 101 U. S. 256, 259; *Huber* v. *Nelson Mfg. Co.*, 148 U. S. 270, 289; *Union Switch & Signal Co.* v. *Louisville Frog, Switch & Signal Co.*, C. C. A. 6, 73 F. (2) 550, 552. Both of these reasons are factual. *Marconi Wireless Telegraph Co.* v. *United States*, 320 U. S. 1, 58. In holding the *Marconi* patent invalid, this Court said:

> "The purpose of the rule that a patent is invalid in its entirety if any part of it be invalid is the protection of the public from the threat of an invalid patent, and the purpose of the disclaimer statute is to enable the patentee to relieve himself from the consequences of making an invalid claim *if he is able to show both that the invalid claim was inadvertent and that the disclaimer was made without unreasonable neglect or delay.* * * * Here the patentee has sustained neither burden." (Emphasis ours.)

Petitioner has continued for over twelve years to hold the invalid claims *in terrorem* over the public and still continues to do so.

The disclaimers filed by the patentees in respect to the original patent are admittedly invalid because they added elements; they were not outright disclaimers required under the law. *Hailes* v. *Albany Stove Co.*, 123 U. S. 582; *Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U. S. 477; *Milcor Steel Co.* v. *Fuller*, 316 U. S. 143.*

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* The motion for summary judgment also included the ground that the original as well as the reissue patent were rendered void because of failure to disclaim claims not distinguishable from the claims specified in the disclaimer. *Maytag Co.* v. *Hurley Machine Co.*, 307 U. S. 243, but this ground was not passed upon specifically.

In the present case the patentees did not merely retain ıe invalid claims in the original patent as in the *Marconi* a:e, but deliberately reasserted the invalid claims in the eissue. The reissue amounted to no more than a repeti-on of the invalid disclaimer; nothing was added to and othing was subtracted by the reissue from the void orig-ıal patent as it stood after the invalid disclaimer.

In respect to the factual question of delay in applying for ıe reissue, this Court has emphasized that:

> "Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described." Ensten v. Simon Ascher & Co., 282 U. S. 445, 453.

1. Petitioner's contention of the District Court's depart-re from "due process" is totally groundless for the simple ason that the District Court did not raise the question delay *sua sponte* as erroneously asserted by petitioner. his opinion (R. 057) granting the motion for summary dgment, Judge Moore said: "Defendant finally urges at the entire reissue patent is invalid on the ground that e application for it was not timely. On this ground, the otion must be sustained." This ground for invalidity of e reissue was argued orally and was discussed in the iefs of both parties. As respondent did not file any eading prior to its motion for summary judgment, Rule c) of the Rules of Civil Procedure does not apply. On e other hand, the matter of laches or delay in filing of e reissue was argued in respondent's brief *filed and rved at the same time as the motion for summary judg-nt*, and petitioner was allowed one month within which submit its brief, and in that brief it argued that the re-ue was not untimely.

Apart from the fact that there is no merit in the peti-ner's argument of departure from due process, this was t raised in the District Court and was not properly raised

in the Court of Appeals. In the District Court, no petition for rehearing was presented. In the Court of Appeals the petitioner designated only part of the record and proceedings in the District Court for the transcript on appeal and in the statement of the points to be relied upon did not specify the point which it now urges. Rule 75(d) Rules of Civil Procedure. Accordingly, the Court of Appeals was right in disregarding it. *Jesionowski* v. *Boston & M.R.R.*, 329 U. S. 452, 458.

2. There is no conflict of law involved in the decision of the Court of Appeals. The only questions decided by the Court of Appeals are factual questions to which well established principles of law were applied. The cases of this Court relied upon by petitioner do not show conflict of law; quite the contrary. In none of those cases was there lacking the statutory requirement of inadvertence, accident or mistake; and in none of those cases was there an unreasonable delay in filing a disclaimer; while, on the other hand, these two deficiencies are present in the instant case and are fatal to the validity of the reissue as to all of the claims. Similarly, there is no conflict between the instant case and the Court of Appeals case, *Foxboro Co.* v. *Taylor Instrument Co.*, 157 F. (2d) 226, referred to only in a footnote (Pet. 7) but apparently relied upon by petitioner to show confiict. That case, however, is in harmony with the decision of the Court of Appeals in the present case. In that case there was an outright disclaimer, not a disclaimer which added elements and moreover the matter of disclaimer was *obiter* because the Court of Appeals held the claims invalid for lack of invention. In that case Judge Learned Hand stated that the patentee had not forfeited his patent because of failure to disclaim certain of his claims, and then went on to say (157 F. 2d, 227): "A different question would have arisen had original claim 4 not been in the patent and had Mason disclaimed claims 2

and 3 and then attempted to revive claim 3, adding to it the new element by which original claim 4 was different from original claim 3." That is precisely the question decided in the present case because here claims 13, 14, 18 and 19 were not in the original patent but are the same as the claims as modified by the disclaimer which added elements by which the disclaimed claims differed from the original claims which were in the original patent and had been conceded to petitioner's adversaries in the interference. Also, the decision in the present case is in harmony with the decision of the Court of Appeals, Sixth Circuit, in *Union Switch & Signal Co.* v. *Louisville Frog, Switch & Signal Co.*, 73 F. 2d, 550, 552 in which the Court held the reissue patent void because granted without authority of the reissue statute, specifically because of the absence of the statutory requirement of "inadvertence, accident or mistake."

3. Finally, there is no important question of patent law which has been decided by the Court of Appeals and not previously decided by this Court. Specifically, the Court of Appeals did not decide the question drafted by petitioner, and such question may never arise. Nor is there any showing of "importance". On the contrary, the questions which have been decided are only questions of fact to which the principles repeatedly announced by this Court and in numerous cases of Courts of Appeal are applicable.

The three reasons set forth in the petition and supporting brief will be discussed now in further detail in the order in which they have been set forth by the petitioner, and it will be further shown that no reason for the allowance of the writ exists and that, therefore, the petition should be denied.

Refutation of Petitioner's First Point As To Departure From Due Process

The first reason (Pet. 5-7) asserts that the Court of Appeals "sanctioned a departure by the District Court from the accepted and usual concepts of 'due process of law' and of 'laches'."

This point is completely without merit and is contrary to the facts, as will presently appear. At the outset, it should be noted that the part of the point alleging a departure from "due process" was not raised before the Court of Appeals; the petitioner did not designate the complete record and all the proceedings and did not make a concise statement of this point as required by Rule 75(d) of the Federal Rules of Civil Procedure. *Jesionowski* v. *Boston & M.R.R.*, 329 U. S. 452, 458. Petitioner's statement of points to be relied upon appears in the record, pages 059 and 060. The only point on the question of timeliness of filing the reissue stated by petitioner is "2. The District Judge erred in concluding that the application for the Reissue patent was not timely."

Considering now the absence of merit in petitioner's first point, petitioner makes two contentions, neither of which is substantiated. So far as the requirement of Rule 8 of the Rules of Civil Procedure that "In pleadings to a preceding pleading, a party shall set forth affirmatively * * * laches * * *" is concerned, it is sufficient to note that respondent has not pleaded to a preceding pleading but immediately brought the motion for summary judgment without an intervening pleading. The distinction between pleadings and motions is well understood, and this distinction is expressed in the Rules of Civil Procedure. Thus, for example, paragraph (a) of Rule 7 refers to pleadings and paragraph (b) refers to motions and other papers. Rule 12 provides for the presentation of defenses and objections by "pleading or motion", and in paragraph (b)

the distinction between pleadings and motions is made crystal clear. As stated in Moore's Federal Practice, Second Edition, page 1511: "A motion is not a pleading, although certain of the rules relative to pleadings are made applicable to motions by Rule 7(b) (2)." The part of Rule 7 just mentioned refers to "captions, signing and other matters of *form* of pleadings."

The suggestion on page 6 of petitioner's brief that the question of laches was raised *sua sponte* by the District Court is directly contrary to the fact expressly stated by Judge Moore in his opinion (R. 054). More specifically, Judge Moore said (R. 057):

> "Defendant finally urges that the entire reissue patent is invalid on the ground that the application for it was not timely. On this ground the motion must be sustained."

The point that the application for the reissue was not timely was urged in the brief which was submitted with the motion *at the time the motion was served and filed,* pursuant to the requirement of the Rules of the District Court. The hearing on the motion was held June 1, 1951 and after the hearing petitioner requested and was granted until the first of the following month, more than 30 days, to file its brief, and in petitioner's brief the question of timeliness of the application for reissue was discussed. Petitioner did not request rehearing following the District Court's decision.

The rest of petitioner's point is a discussion of a question of fact decided both by the District Court and the Court of Appeals adversely to the petitioner. Rule 52 of the Rules of Civil Procedure was correctly applied by the Court of Appeals. The requirement for diligence in applying for a reissue as soon as the mistake sought to be corrected is discovered is not subject to question at this late date in view of the numerous decisions of this Court including *Miller* v. *The Brass Company,* 104 U. S. 350, 354;

Topliff v. *Topliff et al.*, 145 U. S. 156; *Ensten* v. *Simon Ascher & Co.*, 282 U. S. 445; *Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U. S. 477; *Marconi Wireless Telegraph Co.* v. *United States*, 320 U. S. 1, 58; *Milcor Steel Co.* v. *Fuller*, 316 U. S. 143, 148.

Moreover, the petitioner has overlooked the fact that as this Court stated in the *Marconi* case, cited in the preceding paragraph and quoted on page 6, in our Summary of Argument, it is incumbent upon the patentee to establish that he acted "without unreasonable neglect or delay". Although the *Marconi* case related specifically to a disclaimer, unduly delayed, it is well understood that the same principle applies *a fortiori* to reissues. *Miller* v. *The Brass Company*, 104 U. S. 350, 354; *Topliff* v. *Topliff, et al.*, 145 U. S. 156; *Mahn* v. *Harwood*, 112 U. S. 354, 359; *Roos* v. *McMillan*, C. C. A. 6, 64 F. (2) 568, 570.

Refutation of Petitioner's Second Point As To Conflict of Decision

The second reason (Pet. 7 to 10) asserts conflict with decisions of this Court and with decisions in other circuits and has two parts, namely, (a) invalidity of the reissue as to all of the claims when there is no inadvertence, accident or mistake and no valid disclaimer either prior to the reissue application or after the issuance of the reissue patent, and (b) as to the requirement of diligence in applying for reissue as soon as the mistake is discovered.

There is no conflict in respect to either of these parts of this point. The answer to both parts has been given by this Court in *Marconi Wireless Telegraph Co.* v. *United States*, 320 U. S. 1, 58 (cited in the opinion of the Court of Appeals). In that case this Court pointed out at page 58 that questions of inadvertence and unreasonable delay are questions of fact. The reissue statute under which the patent in suit was issued made inadvertence, accident or

mistake indispensable to the valid reissue of an original patent, and this is not disputed by petitioner. *Leggett* v. *Avery,* 101 U. S. 256; *Mahn* v. *Harwood,* 112 U. S. 354.

Petitioner deliberately chose to ignore the emphatic admonition of this Court in the *Altoona* case; it preferred cases of lower Courts which either did not mention the *Altoona* case or which, as Judge Learned Hand said in the *Milcor* case, 122 F. (2) 292, 295, "have attempted to make a distinction (from the Altoona case) but with deference we cannot understand the reasoning." This was not the case in the Eighth Circuit where petitioner is located and where this action was brought. Moreover, as Judge Moore points out, "Judge Hand's opinion in the Milcor case is dated *three months prior to the filing of the disclaimers*" (R. 057, emphasis ours). At any rate, the law always was as announced by this Court in the *Altoona* case and petitioner, if it relied upon contrary decisions of lower Courts, did so at its peril and its action could not survive the peril it deliberately chose to risk (Pet. 5, question 4). There was no just reason for petitioner to ignore the *Altoona* case; it could have filed an outright disclaimer and applied for a reissue as soon as it learned that its adversaries in the interference were prior inventors of the device. The concession of priority in the interference and the disclaimer filed at about the same time as the concession of priority conclusively establish lack of inadvertence, accident or mistake required as a condition precedent to the validity of a reissue patent. *Leggett* v. *Avery,* 101 U. S. 256, 259; *Huber* v. *Nelson Mfg. Co.,* 148 U. S. 270, 289; *Union Switch & Signal Co.* v. *Louisville Frog, Switch & Signal Co.,* 6th Cir. 73 F. (2) 550, 552; *General Radio Co.* v. *Allen B. DuMont Laboratories,* C. C. A. 3, 129 F. (2) 608, 611. As stated in "Robinson on Patents", a highly regarded text on patent law, Vol. II, page 388:

> "A voluntary and intelligent disavowal of any matter which is embraced in the original description of the invention is conclusive evidence of its intentional

> exclusion from the patent. This disavowal may consist in an express disclaimer embodied in the specification, *or filed subsequently to the issue of the patent, or in the conduct of the inventor toward his application during the proceedings in the Patent Office.* * * * in none of these cases can the undue restriction of the Claim be attributed to inadvertence, accident or mistake." (Emphasis ours.)

The decisions of this Court referred to at the top of page 8 of the petition do not support petitioner's contention that original claims which are carried over into the reissue patent are valid in cases where, as in the instant case, the reissue patent is exactly the same as the original patent as modified by an invalid disclaimer or where the statutory requirement of inadvertence, accident or mistake is not proven by the patentee, which is the situation in the present case. *Gage* v. *Herring* was decided on the basis that the statutory requirement of inadvertence and mistake was proven and there was no unreasonable delay in filing the disclaimer, 107 U. S. 640, 646. In *Mahn* v. *Harwood,* the reissue was held invalid as to the broadened claims and the other claims which were carried over from the original patent were held not infringed so that it was unnecessary to decide that they were invalid. In that case the Court said at page 359, " * * * and it is no doubt a general rule that where the Commissioner has exceeded his authority in granting or reissuing a patent, such fact furnishes a good defence to a suit brought for its infringement. There are stronger reasons for this defence against patents for inventions, which directly affect the citizen, than exist in the case of patents for land, which directly affect the Government, and only indirectly the citizen". Earlier in its decision, on the same page, 359, this Court pointed out, "The same defence may be established by showing from the record that there was no inadvertence, accident or mistake * * *."

In *Yale* v. *Sargent,* 117 U. S. 536, the reissue patent was held invalid because of the long delay in applying for it,

but it was held valid as to certain other claims because it was expressly found that there was no unreasonable delay in filing a disclaimer. In the present case, on the other hand, the reissue patent fails to satisfy the statutory requirement for inadvertence, accident or mistake, for the very reason that the disclaimer is invalid. In the last case relied upon by the petitioner, *Liggett* v. *Standard Oil Co.*, 149 U. S. 287, the question of inadvertence, accident or mistake was not involved and neither was the question of an invalid disclaimer.

Thus the decision of the Court of Appeals in this case is by no means in conflict with any of the decisions of this Court relied upon by the petition, for none of those cases holds or states that claims carried over from an original patent into a reissue may be valid even though the statutory requirement of inadvertence, accident or mistake is lacking, as in the present case and even though the disclaimer statute was violated, as in this case. After those cases were decided, this Court repeatedly held that unreasonable delay in entering a disclaimer results in the entire patent being invalid. *Ensten* v. *Simon Ascher*, 282 U. S. 445; *Maytag Co.* v. *Hurley Machine Co.*, 307 U. S. 243; *Marconi Wireless Telegraph Co.* v. *United States*, 320 U. S. 1. And moreover, this Court has more recently indicated that the lower Courts should fully inquire into the validity of a patent rather than to dispose of a case on the ground of non-infringement. *Sinclair & Carroll Co.* v. *Interchemical Corporation*, 325 U. S. 327, 330.

The only Court of Appeals case relied upon by petitioner as in conflict with the decision of the Court of Appeals of the present case is referred to in a footnote to page 7 of petitioner's brief, namely *Foxboro Co.* v. *Taylor Instrument Co.*, 157 F. (2) 226, 228 (Cert. Den., 329 U. S. 800) which was decided by the Court of Appeals for the Second Circuit. However, that case only thus casually referred to by the petitioner is not in conflict with the decision of the Court of Appeals in this case but to the contrary indi-

cates the principle which was applied in the instant case. In the *Foxboro* case, there was an *outright* disclaimer, not a disclaimer which added elements to the claim, and apart from this, the reissue patent was held invalid as to all of the claims relied upon by the claimant. Thus, the question whether the claims carried over from the original patent to the reissue patent were valid, if patentable over the prior art contrary to the conclusion reached by the Court of Appeals in that case, did not require any answer and it was not necessary to decide whether in such case the claims would have been invalid because of the failure to disclaim claims not distinguishable from claims which had been disclaimed in the original patent.

Moreover, Judge Hand pointed out, in respect to the point made by the defendant that the patent was forfeited because of failure to disclaim certain of the claims, that the question would have been different "had original claim 4 not been in the patent, and had Mason disclaimed claims 2 and 3 and then attempted to revive claim 3, adding to it the new element by which original claim 4 was different from original claim 3" (157 F. (2) 226, 227). Furthermore it is perfectly clear that the Second Circuit case differs factually from the present case in respect to the specific point decided by the Court of Appeals in the present case, namely the absence of inadvertence, accident or mistake in the present case, and that was not a factor in the Second Circuit case.

As to part (b) of petitioner's second point, it has been pointed out previously that the question of delay in applying for reissue is a question of fact for the trial Court and the finding of the trial Court on that question is binding on the Court of Appeals unless it is clearly erroneous. Rule 52, Federal Rules of Civil Procedure; *Marconi Wireless Telegraph Co.* v. *United States,* 320 U. S. 1, 58. In *Mahn* v. *Harwood,* 112 U. S. 354, 363, this Court said "As we have already stated, no invariable rule can be laid down as to what is reasonable time within which the patentee

should seek for the correction of a claim which he considers too narrow. In *Miller* v. *The Brass Company,* by analogy to the law of public use before an application for a patent, we suggested that a delay of two years in applying for such correction should be construed equally favorable to the public. But this was a mere suggestion by the way, and was not intended to lay down any general rule."

As the Court of Appeals for the Sixth Circuit has said, "No fixed rule can be laid down as to what constitutes an unreasonable delay." *Roos* v. *McMillan,* 64 F. (2) 568, 570. In the case just cited a delay of only six months was held too long to justify a reissue application. In *Better Packages, Inc.* v. *Derby Sealers, Inc.,* 43 F. Supp. 123, the delay in the case of a narrowed reissue patent was only a few months after the patentee was told that his claims were too broad (43 F. Supp. 684) not two and a half years as stated on page 9 of the petition. In *Better Packages, Inc.* v. *Link & Co.* (C. C. A. 2) 74 F. (2) 679, the delay in filing a disclaimer held unreasonable was only eighty-three days. In *Laufenberg, Inc.* v. *Goldblatt Bros., Inc.,* 179 F. (2) 832, C. C. A. 7, the delay in filing a disclaimer was only nine months, and in both of these last mentioned cases the delay was held unreasonable because, as stated in *Ensten* v. *Simon Ascher,* 282 U. S. 445, 453.

> "Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described."

Refutation of Petitioner's Third Point As To An Important Question of Patent Law

The third point is that the Lower Court had decided an important question of patent law which has not been settled by this Court.

The question presented by the petition, namely, "whether the filing of an improper disclaimer (designed to cure a

mistake in the original patent) makes the original mistake unavailing as a ground for reissue" has *not* been decided by the Court of Appeals, and moreover, it does not appear that the question is important. In the first place, the petitioner did not attempt to cure the original mistake by reissue. On the contrary, petitioner deliberately included in the reissue all of the claims including the very same claims of the invalid original patent as modified by the admittedly improper disclaimer and the Court of Appeals held that petitioner did not establish the statutory requirement of inadvertence, accident or mistake. Specifically, the Court of Appeals held that "The filing of the invalid disclaimers and the concession of priority of invention were deliberate acts and not the result of inadvertence. They were evidently considered to be necessary and advantageous at the time they were filed" (R. 238). It is pertinent to observe that petitioner did not at any time during the pendency of the application for reissue inform the Patent Office that the application included the four claims as modified by the invalid disclaimer. In that connection the Court of Appeals said (R. 238):

> "We think it was manifest error for the appellant to include these four invalid claims in its application for a reissue patent and for the Commissioner to include them therein. See Leggett v. Avery, 101 U. S. 256."

If petitioner had wished to cure the original mistake by reissue, the invalid claims should have been omitted from the reissue, but instead of doing that petitioner has continued *for almost twelve years,* ever since the concession of priority and the adverse decision on priority, to hold these invalid claims *in terrorem* over the public.

It is apparent from the opinion of the Court of Appeals that there has been no decision by that Court on the question drafted by the petitioner. The Court of Appeals took pains to point out in its opinion that the reissue did not

attempt to eliminate the original mistake but t
instant case the disclaimer was filed before the
for the reissue patent was filed, and instead of
an invalid feature it added one which was carrie
the application for the reissue and is included
issue" (R. 238).

Since the question as drafted by the petitio
substantiated by the record, the question and
importance are both moot. Apart from this,
there is no showing of "importance". The reis
case at bar will expire in about three years and t
matter thereof is of minor importance, as may
from the numerous patents in the record for
vices (R. 125 to 206), which are only a few o
many patents for similar devices. The three
patents referred to in the petition, page 10, are
outside of the record and undoubtedly involve the question
issues, but are also obviously incompetent to
presence of even one iota of importance in the
presented. Two of those three reissue patents
pired without decision of any Court of Appeals
and the third reissue patent will expire in less
years and it does not appear that there is any
which would involve the question presented.
the question, although interesting as a topic of
phical discussion, has not been decided by any
Appeals, is apparently not involved in any
and is not likely to be, and is not now of any

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RESPONDENT'S POINTS

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The aspects of this case brought out in the follow
and not mentioned by petitioner, serve to emph
correctness of the decision of the Court of Appeals
they were not specifically discussed in the Court's

The Patent Is Void for Not Disclaiming All That Should Have Been Disclaimed

This Court decided in *Maytag Co.* v. *Hurley Machine Co.*, 307 U. S. 243, 245, that the disclaimer statute is not complied with if claims not definitely distinguishable from the parts claimed without right are not disclaimed. There are at least several claims of the original patent which are also present in the reissue patent and which are not definitely distinguishable and which have not been disclaimed. In particular, claims 7 and 9 are not definitely distinguishable from claim 14 which petitioner lost in the interference and with respect to which the invalid disclaimer was entered. These claims are analyzed and compared in the record (086-088) by respondent's patent expert. These invalid claims have nevertheless been retained by petitioner ever since the issuance of the original patent *more than thirteen years ago.*

The Reissue Statute And The Disclaimer Statute Are Not Cumulative In Respect To The Same Change To Be Made In a Patent

Judge Moore of the District Court stated this point in his opinion (R. 058) and it is submitted that the correctness of this principle is obvious from the statement thereof when it is remembered that both statutes provide for correction of an original patent *only* if inadvertence, accident or mistake is established. The inadvertence, accident or mistake of overclaiming could have been availed of by the petitioner after the adverse decision in the interference by filing a proper outright disclaimer in the original patent, but this the petitioner deliberately abstained from doing and thereby forfeited the patent under the doctrine em-

phatically reiterated by this Court in *Ensten* v. *Simon Ascher,* 282 U. S. 445, 453, and again in *Marconi Wireless Telegraph Co.* v. *United States,* 320 U. S. 1, 58, as well as in other decisions of this Court.

As the reissue patent is the same in all respects as the void original patent as it stood after the disclaimer, it follows, as a matter of principle, that the reissue is also void. The patentee destroyed the original patent by the invalid disclaimer and cannot be allowed to circumvent the void patent by obtaining a patent which differs only in form from the void patent.

The Original Patent Was Invalid Because of the Failure to Disclaim In the Manner Required by the Disclaimer Statute, Not for the Reasons Specified in the Reissue Statute as Grounds for Reissue

This was also pointed out by Judge Moore of the District Court in his opinion (R. 058). This point emphasized that there was no statutory ground for the Commissioner's action in approving the application for reissue, because the reissue statute unquestionably does not include the invalidity of a disclaimer as ground for a reissue but only provides that a reissue may be obtained if the patent is wholly or partly inoperative or invalid, and then only if either of the two reasons specified therein are present, namely (1) a defective or insufficient specification, or (2) by reason of the patentee claiming more than he had a right to claim as new—provided always that "the error has arisen by inadvertence, accident or mistake". Thus, there was no basis for the reissue, not only because there was no inadvertence, accident or mistake, but also because the patent was invalid because of the failure to comply with the disclaimer statute and not because of the reasons specified in the reissue statute as just stated.

CONCLUSION

We submit that for the foregoing reasons the Petition for writ of certiorari should be denied.

Respectfully submitted,

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